

REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims comply with 35 U.S.C. § 101, are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.

The applicants will now address each of the issues raised in the outstanding Office Action.

Rejections under 35 U.S.C. § 101

Claims 1-46 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claim 1 has been amended to recite "a computer-implemented method" and to recite that each of the acts are performed with "a web-based email serving system including at least one computer." Furthermore, claim 1, as amended, recites storing, reading, and serving ads). Thus, claim 1, as amended, is tied to a particular apparatus. Independent claim 43 has been

similarly amended. Independent claim 19, as amended, recites "a computer-implemented method" including acts performed with "a client device." Claim 19, as amended, further recites rendering various items by the client device. Independent claims 34, 40 and 45 have been similarly amended. These amendments are supported, for example, by paragraphs [0064]-[0068] of the present application. Thus, in view of the foregoing amendments and remarks, claims 1-46 are directed statutory subject matter under 35 U.S.C. § 101. The applicants respectfully request that the Examiner withdraw this ground of rejection.

Rejections under 35 U.S.C. § 102

Claims 1-23, 25-69 and 71-92 stand rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent Application Publication No. 2003/0191689 ("the Bosarge publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, independent claims 1 and 47, as amended, are not anticipated by the Bosarge publication because the Bosarge publication does not teach accepting, with the web-based e-mail serving system, an ad request from **the client device**. In rejecting original claims 1 and 47, the Examiner cites paragraphs [0013]-[0018] of the Bosarge publication as teaching the features of original claims 1 and 47. (See Paper No. 20080913, page 3.) The applicants respectfully disagree.

In the **accepting** act of the claimed method, embodiments consistent with the claimed invention **accept**

an ad request from the client device. Requesting and serving an ad occur separately. This permits exemplary embodiments consistent with the claimed invention to "provide an asynchronous and opportunistically available solution that allows the user's e-mail to be rendered immediately, and then updated with appropriate advertisements if and when they became available." (See paragraph [0079] of the present application.)

By contrast, the Bosarge publication does not teach accepting ad request from a client device at all. The Bosarge publication states "electronic messages" are enhanced by "attaching a relevant, contextual advertising tag line or image/banner/words/HTML/Flash, etc. to the electronic message, and transmitting the enhanced message to a receiver." (Abstract of the Bosarge publication) Figure 2 of the Bosarge publication illustrates this directional process flow, wherein "email is sent directly to the OpenMX Mail Server... ads are pulled and appended ... to provide and transmit to the recipient an enhanced email." (Paragraph [0057] of the Bosarge publication) Since the ads are already appended to the electronic message, there is no need for the receiving device to request the ads. Even the "hyper linked word" disclosed in paragraph [0054] of the Bosarge publication would request ads after the enhanced message (along with the appended ads) has been rendered to the receiver. Therefore, Bosarge publication does not teach an act of accepting an ad request from the client device as claimed.

Thus, independent claims 1 and 47, as amended, are not anticipated by the Bosarge publication for at least the foregoing reasons. Since claims 2-18 directly or

indirectly depend from claim 1, and since claims 48-64 directly or indirectly depend from claim 47, these claims are similarly not anticipated by the Bosarge publication. Independent claims 34, 40, 45, 80, 86 and 91, as amended, are similarly not anticipated by the Bosarge publication. Since claims 35-39 directly or indirectly depend from claim 34, since claims 41 and 42 directly or indirectly depend from claim 40, since claim 46 depends from claim 45, since claims 81-85 directly or indirectly depend from claim 80, since claims 87 and 88 depend from claim 86 and since claim 92 depends from claim 91, these claims are similarly not anticipated by the Bosarge publication.

Second, independent claims 19 and 65, as amended, are not anticipated by the Bosarge publication because the Bosarge publication does not teach **rendering**, with a client device, **the at least one ad in association with the rendered document, wherein the at least one ad is rendered after the e-mail content of the document has already been rendered.** In rejecting original claims 19 and 65, the Examiner cites paragraphs [0013]-[0018] of the Bosarge publication as teaching the features of original claims 19 and 65. (See Paper No. 20080913, page 6.) The applicants respectfully disagree.

The Bosarge publication does not disclose the client device rendering ad after the e-mail content of the document has already been rendered. Paragraph [0018], cited by the Examiner, states "the service provider intercepts and ... add[s] tag lines ... to the intercepted email..." before transmitting the enhanced electronic message to the recipient. Thus, the tag lines and the content of the electronic message are rendered together at the recipient in the enhanced e-mail.

Further, FIG. 1a, relied on by the Examiner, does not disclose a screen of a client device displaying a message being rendered separately from the ads. Rather, FIG. 1a is "a plain-text un-enhanced electronic message" **prior** to being intercepted and being enhanced by advertising tag lines, etc. (and therefore before the message is rendered by the recipient), while FIGS. 1b and 1c are enhanced electronic messages. (Paragraph [0041] of the Bosarge publication) Therefore, Bosarge publication clearly does not teach rendering the at least one ad in association with the rendered document, wherein the at least one ad is rendered after the e-mail content of the document has already been rendered.

Thus, independent claims 19 and 65, as amended, are not anticipated by the Bosarge publication for at least the foregoing reasons. Since claims 20-29 directly or indirectly depend from claim 19, and since claims 66-79 directly or indirectly depend from claim 65, these claims are similarly not anticipated by the Bosarge publication. Independent claims 43 and 89, as amended, are similarly not anticipated by the Bosarge publication. Since claim 44 depends from claim 43, and since claim 90 depends from claim 89, these claims are similarly not anticipated by the Bosarge publication.

Further, embodiments consistent with the invention as claimed in dependent claims 21 and 67 **request** at least one ad relevant to the e-mail content of the document **after** the act of rendering the e-mail content of the document occurs. Thus, dependent claims 21 and 67 are not anticipated by the Bosarge publication for at least this additional reason.

Rejections under 35 U.S.C. § 103

Claims 24 and 70 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Bosarge publication. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claims 24 and 70 indirectly depend from claims 19 and 65 respectively. The purported allegation that instantiating an ActiveX object in order to pull an ad is old and well known art would not compensate for the deficiencies of the Bosarge publication with respect to claims 19 and 65 (discussed above), regardless of whether the instantiating is old and well known art, and regardless of the absence or presence of an obvious reason for a person of ordinary skill in the art "to know that Bosarge would instantiate ActiveX to obtain ads." (Paper No. 20080913, page 13) Consequently, claims 24 and 70 are not rendered obvious by the cited reference and the Official Notice for at least this reason.

Claim amendments

In addition to the claim amendments discussed above, claims 47, 65, 80, 86, 89 and 91 have been amended to replace means-plus-function elements and to include at least one processor, an input device, and at least one storage device storing a computer-executable code which, when executed by the at least one processor, performs a method. These amendments are supported, for example, by Figure 4 and paragraphs [0064]-[0068] of the present application..

Amendments to the Specification and Drawings

The specification has been amended, to insert previously unavailable information.

Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.


Any arguments made in this amendment pertain **only** to the specific aspects of the invention **claimed**. Any claim amendments or cancellations, and any arguments, are made **without prejudice to, or disclaimer of**, the applicants' right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Since the applicants' remarks, amendments, and/or filings with respect to the Examiner's objections and/or rejections are sufficient to overcome these objections and/or rejections, the applicants' silence as to assertions by the Examiner in the Office Action and/or to certain facts or conclusions that may be implied by objections and/or rejections in the Office Action (such as, for example, whether a reference constitutes prior art, whether references have been properly combined or modified, whether dependent claims are separately patentable, etc.) is not a concession by the applicants

that such assertions and/or implications are accurate, and that all requirements for an objection and/or a rejection have been met. Thus, the applicants reserve the right to analyze and dispute any such assertions and implications in the future.

Respectfully submitted,

December 23, 2008

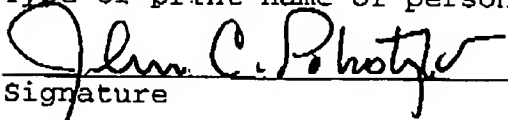

John C. Pokotylo, Attorney
Reg. No. 36,242
Tel.: (732) 936-1400

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (and any accompanying paper(s)) is being facsimile transmitted to the United States Patent Office on the date shown below.

John C. Pokotylo

Type or print name of person signing certification


Signature

December 23, 2008

Date